

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

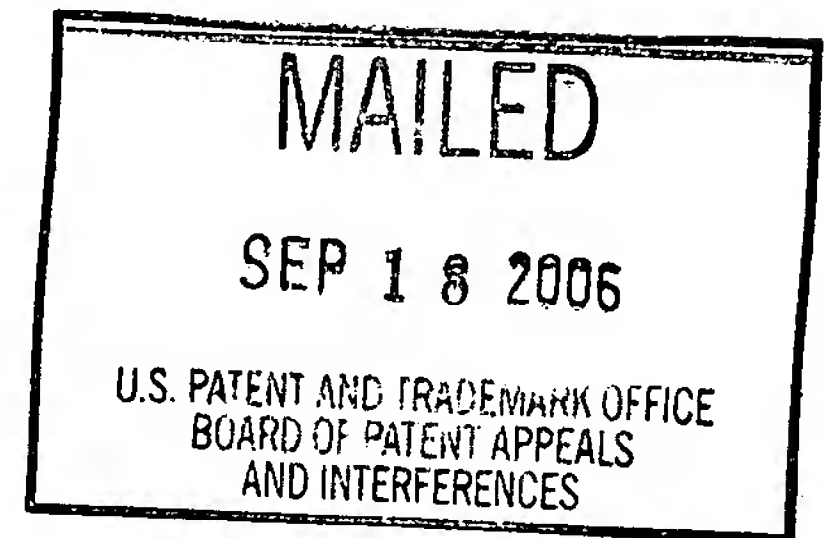
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ARMANDO R. LOPEZ

Appeal No. 2006-1057
Application No. 10/051,994

ON BRIEF



Before MILLS, GRIMES and LEOVITZ, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4, 6-12 and 18.

Claims 1, 3 and 13 read as follows:

1. A skin protective composition for topical use that can prevent contact and passage to the skin of toxic chemicals and irritants found in the cosmetic industry comprising a cosmetic vehicle or base and about 1.0 to about 10% by weight of a lathering surfactant said composition being readily removable with water.

3. A skin protective composition according to Claim 1 wherein said vehicle or base contains at least one lipid substantially insoluble in water.

13. A skin protective composition according to claim 3 wherein said lipid is a member selected from the group consisting of petrolatum C 10-30

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cholesterol/lanosterol esters, beeswax, polyethylene wax, paraffin, triglyceryl mono stearate, decaglyceral stearate and polyglyceryl stearate.

The prior art references cited by the examiner are:

| | | |
|------------------------|-----------------|----------------|
| Noll | 5,725,875 | Mar. 10, 1998 |
| McAtee et al. (McAtee) | 5,942,238 | Aug. 24, 1999 |
| Kelly et al. (Kelly) | 3,961,044 | June 1, 1976 |
| Guck | EP 0 626 167 A2 | April 25, 1994 |

Grounds of Rejection

Claims 1-4, 6-12 and 18 stand rejected under 35 U.S.C. § 103(a) over Noll in view of Guck as evidenced by McAtee. Claim 13 is also rejected over these references in further view of Kelly.

We affirm these rejections.

Claim Grouping

Appellant does not argue any claim separately with respect to the 35 U.S.C. § 103 rejection. Therefore, we select claims 1 and 13 as representative of the rejected claims. 37 C.F.R. § 41.37(c)(1)(vii) (September 13, 2004).

DISCUSSION

Obviousness

Claims 1-4, 6-12 and 18 stand rejected under 35 U.S.C. § 103(a) over Noll in view of Guck as evidenced by McAtee. Claim 13 is also rejected over these references in further view of Kelly.

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We begin with claim interpretation. Appellant's claims are broad in scope. Appellant essentially claims a composition comprising a cosmetic base and 1-10% of a lathering surfactant. We interpret the preamble claim language, "skin protective composition for topical use that can prevent contact and passage to the skin of toxic chemicals and irritants found in the cosmetic industry," as a recitation of intended use which is given no patentable weight. Pitney Bowes Inc. v. Hewlett Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). ["If ... the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation."]

The use of the transitional phrase "comprising" in the composition claim before us indicates that the elements or steps following the transition may be supplemented by additional elements or steps and still fall within the scope of the claim. See, e.g., Scanner Technologies Corp. v. ICOS Vision Systems Corp., 365 F.3d 1299, 1303, 70 USPQ2d 1900, 1904 (Fed. Cir. 2004).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). An obviousness analysis requires that the prior art both suggest the claimed subject matter and reveal a reasonable expectation of success to one reasonably skilled in the art. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Although we agree that the prior art cited by the examiner supports a prima facie case of obviousness, our reasoning differs from that of the examiner and for this reason we designate our decision a new ground of rejection to provide appellant a full and fair opportunity to address any additional issues or concerns.

Guck describes a skin protecting foam containing stearate and sorbitol (a cosmetic vehicle) and which may also include a tenside of sodium lauryl sulfate in quantities of 1 to 3 weight%. Guck, pages 4 and 8. Guck describes that the amount of sodium lauryl sulfate tenside can be selected from a range of amounts, 1 to 3%, within the claimed range of foaming surfactant. McAtee discloses that sodium lauryl sulfate is considered a lathering surfactant. Column 7, line 51-56. Claim 1 before us does not recite a specific amount of cosmetic vehicle and thus Guck would appear to disclose a protective composition within the scope of claim 1. McAtee discloses that lowering a composition's surface tension with a surfactant leads to better softening and breaking

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up of the lipid and silicone base of the skin products, to improve removing of the lipid-silicone-containing skin products from the skin. McAtee, column 1, lines 59-64;

Answer, page 3.

Noll also describes a cream composition which dries to form a topical barrier on the skin. The cream can be readily removed with soap and water. Abstract. Noll teaches that protective skin compositions may take the form of suspensions, emulsions, lotions, ointments and aerosol gels that form a film on the skin effective as a topical barrier. Answer, page 3. These limitations are found in dependent claims 2, and 7-9, making these claims obvious as well, based on Noll in view of Guck and McAtee. In our view, claim 1 reads on the prior art of Guck taken with McAtee and Noll.

With respect to dependent claim 13, Guck taken with McAtee teach the topical skin protective composition recited in independent claim 1. The additional limitations of claims 3 and 13 are found in Kelly. Kelly teaches that when skin protective agents take the form of lotions and creams (as described in Noll) it is conventional to add "other known protective agents, such as fatty acids for protection against dry dust, and petroleum jelly or waxes for protection against aqueous solutions." Kelly, column 7, lines 5-26. The examples of Kelly exemplify types of waxes and skin protective ingredients which may be added to skin protective compositions. Example 3 shows that a protective lotion containing stearate may also contain glyceryl monostearate, beeswax, petrolatum and mineral oil. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to add additional skin protective components including beeswax and petrolatum (Kelly) to a skin protective composition comprising stearate (Guck) for their known protective properties.

Appellant contends that, "there is no recognition in Guck that the surfactant serves other than in forming the foam" and there is no suggestion other than in hindsight that the surfactant is to simplify the removal of the composition. Brief, page 6. We are not persuaded by this argument. There is no requirement under the patent law that the surfactant must be recognized in the prior art as serving the same function.

A prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. See id. In the present case, Guck includes a cosmetic base and a foaming surfactant in the claimed amounts. Thus, Guck need not recognize that the surfactant functions to assist in removal of the composition to be considered prior art. McAtee discloses that lowering a composition's surface tension with a surfactant leads to better softening and breaking up of the lipid and silicone base of the skin products, to improve

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removing of the lipid- silicone- containing skin products from the skin. McAtee, column 1, lines 59-64; Answer, page 3.

Moreover, McAtee recognizes that the presence of a surfactant, such as that present in Guck, assists in removal of the composition, particularly if that composition contains lipid or silicone ingredients. McAtee, column 9, lines 28-34.

In view of the above, we find the examiner has provided sufficient evidence to support a prima facie case of obviousness of claims 1 and 13 which remains unrebutted by appellant. Remaining claims fall with independent claims 1 and 13.

CONCLUSION

The rejection of claims 1-4, 6-12 and 18 under 35 U.S.C. § 103(a) over Noll in view of Guck as evidenced by McAtee is affirmed. The rejection of claim 13 in further view of Kelly is also affirmed. As our analysis varies from that of the examiner, we designate our decision in this appeal as a new ground of rejection.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

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37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) *Request rehearing.* Request that the proceeding be reheard
under § 41.52 by the Board upon the same record. . . .

AFFIRMED, 37 C.F.R. §41.50(b)



Demetra J. Mills
Administrative Patent Judge



Eric Grimes
Administrative Patent Judge



Richard M. Lebovitz
Administrative Patent Judge

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